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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,118	05/23/2000	Paul Lapstun	NPA012US	9159

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Kia Silverbrook
Silverbrook Research Pty Ltd
393 Darling Street
Balmain,
AUSTRALIA

EXAMINER

JORGENSEN, LELAND R

ART UNIT

PAPER NUMBER

2675

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22

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/575,118

Applicant(s)

LAPSTUN ET AL.

Examiner

Leland R. Jorgensen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 - 60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 - 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 47 – 50 and 54 - 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cass, USPN 5,692,073, in view of LaMarca et al., USPN 6,279,013 B1.

Claims 47 and 54

Claim 47 describes a method of enabling navigation of a directory. Claim 54 describes a system for enabling navigation of a directory.

As to claim 47, Cass teaches printing 2200 a document 1100 containing a list of directory entries 1101, 1102. The directory entries correspond to at least one node of an index of the directory 420. At least one interactive element enables a user to indicate a request for further directory information by interacting with the element using a sensing device which is adapted to transmit request data 2200 to a computer system 100. Cass teaches printing the further directory 2272 on a document 1110, 1120. Cass, col. 8, lines 30 – 35; col. 10, lines 13 – 17; col. 17, lines 4 – 26; figures 2, 4, 5, 21 and 22.

As to claim 54, Cass teaches a computer system 100 for formatting a document 1100 with a list of directory entries 1101, 1102 corresponding to at least one node of an index of the

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directory and at least one user interactive element to enable a user to request further directory information. Cass teaches a printer 104 for printing the document. Cass, col. 8, lines 30 – 35; col. 10, lines 13 – 17; col. 17, lines 4 – 26; figures 2, 3, 4, 5, 21 and 22. Cass teaches a sensing device for interacting with the element and transmitting request data to the computer system to facilitate the further information being sent from the computer system to the printer for printing in a further document. Cass, col. 6, lines 20 – 24.

Cass does not specifically teach that the list of directory entries and the coded data is printed substantially simultaneously.

LaMarca teaches that the list of directory entries [assorted content items 12, 14, 16] and the coded data [associated tokens 18, 20, 22, 24] are printed substantially simultaneously. LaMarca, col. 5, lines 4 – 12 and 34 – 40; and figures 1 and 2. LaMarca also teaches a printer 40 for printing a document 10 and 42. LaMarca, figures 1 and 2.

LaMarca teaches receiving data from a sensing device. The indicating data is indicative of an identity of the document and an identity of the at least one user interactive element. LaMarca, col. 3, line 59 – col. 4, line 38; col. 5, lines 1 – 5; col. 6, lines 1 – 8; and figures 1 – 4. LaMarca teaches a sensing device [smart wand 70] being adapted to (a) sense at least some of the coded data when the user touches the sensing device against the surface in the vicinity of selected user interactive element; and (b) generate the indicating data using at least some of the sensed coded data. LaMarca, col. 5, lines 16 – 26; col. 6, lines 24 – 52; and figure 5. LaMarca also teaches identifying, using the indicative data, further directory information relating to the selected user interactive element and providing the further directory information to the user. LaMarca, col. 5, lines 4 – 12 and 34 – 40; and figures 1 and 2.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to combine simultaneous printing of the directory entries and coded data as taught by LaMarca with the method and system for navigating a directory as taught by Cass. LaMarca invites such combination by teaching,

The subject invention relates to the field of document generation systems, and more particularly to a method and apparatus for interacting with a periodically issued document, like a newspaper, to revise the document content to be more customized to an individual subscriber.

The invention is particularly applicable to printed documents which include dataglyphs or tokens representative of the document and the subscriber to the document, wherein subscriber redactions to the document itself can be identified for modifying content and form of future editions. However, the subject invention is applicable to any system which provides routine generation of a document edition, either printed or electronically, and that presents an opportunity for the customized editing of a second edition by general profile guidelines for communicating information indicated by the subscriber as being particularly useful or of interest.

LaMarca, col. 1, lines 4 – 19. LaMarca adds,

The present invention contemplates a new and improved system which overcomes the prolix disadvantages of mass media print communication to effectively combine the advantageous features of the two relevant technologies. That is, the customized newspaper which can now be read on an electronic display, is combined with the affordances and conveniences of a printed paper interface, for a resulting interactive newspaper, customized to a subscriber-identified profile.

LaMarca, col. 1, line 65 – col. 2, line 6. LaMarca teaches the following benefits.

One benefit obtained by use of the present invention is a customizable push system for a mass media document so that readers can adjust by general subject matter what content is presented in subsequent editions of the document.

Another benefit obtained from the subject invention is the provision of a document which is customized to a reader, and thereby comprises a much more efficient presentation, paper consumption and time investment to a reader in ultimately reviewing the document.

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A further benefit of the subject invention is back channel communication from a class of readers to a publisher on the relative interest of a plurality of selected items in the document or a response to explicit questions for the reader, whereby the publisher can have an appreciation of reader interest in different articles and responses to specific questions.

Yet another benefit of the present invention is a convenient vehicle for the subscriber to solicit more detailed or expanded information on a subject only first generally identified by the publisher.

LaMarca, col. 2, line 64 – col. 3, line 17. LaMarca concludes,

The method facilitates back channel interaction from the reader for contemporaneous upgrading of the reader's profile in response to a review of the document content. It is intended that the form of communication must be as easy and convenient as possible for the reader and may simply comprise pen markings on the document in preselected manners, preferably cited in the document itself.

In actual implementation, the system comprises a printing operation at a popular location, such as a commuter station, where both the printer 40 and recycling bin 46 can be conveniently located. The printing operation itself is not envisioned to take very long, since the document is intended to be customized for efficiency in terms of relative subject matter for each individual subscriber.

To this point, the invention has been referred to as a newspaper and in terms of content being produced by a mass media publication. The invention has equal merit within an organization where the publication is more of a newsletter than a newspaper. In this context, the delivery would most likely be via mail boxes and the content would be more specific to that organization. As an example, a customized newsletter may contain content such as updates from information services, internal distribution lists, or menus from the cafeteria.

LaMarca, col. 27 – 49.

Claims 48 and 55

Cass teaches a further directory information includes a list of directory entries corresponding to at least one node of an index. Cass, col. 8, lines 30 – 35; col. 10, lines 13 – 17; col. 17, lines 4 – 26; figures 2, 4, 5, 21 and 22.

Claims 49 and 56

Cass shows first, pervious, next, and last nodes in the sample directory, e.g. "Myna Bird," "Toucans" 1111, and "Parrots" 1112. Cass, figure 21.

Claims 50 and 57

Cass teaches that the further directory information includes a list of further nodes in the directory index. Cass, col. 8, lines 30 – 35; col. 10, lines 13 – 17; col. 17, lines 4 – 26; and figures 2, 4, 5, 21 and 22.

3. Claims 51 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cass in view of LaMarca et al. as applied to claim 1 or 16 above, and further in view of the Microsoft Computer Dictionary, 4th ed.

Claims 51 and 58

Claims 51 and 58 each add that interacting with the at least one user interactive element corresponds to an operation of moving to one of a parent, child or root node of the index.

Although Cass shows a parent/child relationship about the information in figure 21, Cass does not specifically state that the user interactive element corresponds to an operation of moving to one of a parent, child or root node of the index.

The Microsoft Computer Dictionary teaches a parent/child relationship in a file directory. Microsoft Computer Dictionary, p. 332.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the parent/child relationship to organize the index because such organization is an common, effective, and efficient method to organize directory information.

4. Claims 34 – 46, 52, 53, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cass in view of LaMarca et al. as applied to claim 1 or 16 above, or over Cass, LaMarca et al., and the Microsoft Computer Dictionary as applied to claim 51 or 58 above and further in view of Dymetman et al, USPN 6,330,976 B1.

Claims 34 and 41

LaMarca teaches that the sensing device [smart wand 70] is hand-held. LaMarca, col. 5, lines 16 – 26; col. 6, lines 24 – 52; and figure 5.

Claim 34 describes a method of enabling a person to navigate a directory similar to the method described in claim 47 above. Claim 41 describes a system for enabling a person to navigate a directory similar to the system described in claim 54 above. Both add, however, that the indicating data is indicative of a position of the sensing device relative to the list of directory entries.

Neither Cass nor LaMarca teach that the indicating data is indicative of a position of the sensing device relative to the list of directory entries.

Dymetman that the indicating data is indicative of a position of the sensing device relative to the list of directory entries. Dymetman et al, col. 9, lines 16 – 22; col. 11, lines 28 – 43; and figures 1 and 2.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine receiving indicating data indicative of a position of the sensing device as taught by Dymetman with the method and system of enabling navigation of a directory as taught by Cass and LaMarca. Dymetman invites such combination by teaching,

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The invention addresses problems in obtaining automatic actions through a network. It is often difficult to obtain an appropriate automatic action such as access to multimedia information or other information available through a network. This is especially true where the context includes a physical object such as a hardcopy document, and the action should be appropriate to the object.

Dymetman, col. 2, lines 49 – 54. Dymetman adds,

The invention provides techniques that alleviate these problems. The techniques employ action/medium identifiers encoded in machine-readable markings on marking media such as sheets or stickers of paper or documents. Each action/medium identifier identifies an action. The action/medium identifier can be used to obtain an action identifier that can be provided through a network to an action device to produce the action. The action device provides the identified action automatically in response to the action identifier. The action/medium identifier also identifies the marking medium. Because the action/medium identifier identifies both the marking medium and the appropriate automatic action, the marking medium can be used to obtain the appropriate automatic action in a non-disruptive streamlined manner. The user can obtain the automatic action in a way that does not disturb normal reading activity and does not disturb document appearance.

Dymetman, col. 3, lines 22 - 38. Dymetman concludes,

The invention could be applied in various ways.

The invention could be applied in a synchronous mode to provide interactive books, magazines, maps, pocket encyclopedias, product catalogues, examination forms, paper address books, and so forth.

The invention could be applied in an asynchronous mode to allow collection of bookmarks while reading a document such as a newspaper or magazine, after which the bookmarks could be used in a batch to retrieve email clippings or print additional information.

Because the pointer behaves like a paper mouse, it can be used to record manual movements in real time, such as drawing or writing motions. Handwritten notes taken during a meeting or during making or playing of a recording can be captured and processed, handwritten faxes can be sent without using a computer, and freeform information requests can be written in an input rectangle inside an advertisement and transmitted to the sponsor for feedback.

Dymetman, col. 35, lines 2 – 19.

Claims 35 – 38 and 42 – 45

As to claims 35 - 38 and claims 42 – 45, see discussion of claims 48 – 51 and claims 55 – 58 above.

Claims 39, 52, and 59

Dymetman teaches receiving, in the computer system, movement data regarding movement of the sensing device relative to the document and identifying, in the computer system and from the movement data, further directory information relating to a selected node of the index of the directory. Dymetman, col. 11, lines 28 – 43; col. 35, lines 12 – 19; col. 37, lines 10 – 31 and 36 – 50.

Claims 40, 53, and 60

Dymetman teaches sensing its movement relative to the document using the coded data, generating the movement data and transmitting the movement data to the computer system. Dymetman, col. 11, lines 28 – 43; col. 35, lines 12 – 19; col. 37, lines 10 – 31 and 36 – 50.

Claim 46

Dymetman teaches that the computer system is adapted to receive movement data regarding movement of the sensing device relative to the document and interpret said movement of the sensing device as it relates to said at least one node of the index, the sensing device, when moved relative to the document, sensing the reference points using at least some of the coded data and generating the data regarding its own movement relative to the document. Dymetman, col. 11, lines 28 – 43; col. 35, lines 12 – 19; col. 37, lines 10 – 31 and 36 – 50.

Response to Arguments

5. Applicant's arguments filed 14 October 2004 have been fully considered but they are not persuasive. Applicants argue that Cass does not teach that the method or system includes a hand-held sensing device that is adapted to (a) sense at least some of the coded data when the user touches the sensing device against the surface in the vicinity of selected user interactive element; and (b) generate the indicating data using at least some of the sensed coded data. LaMarca, however, teaches a sensing device [smart wand 70] so adapted. See LaMarca, col. 5, lines 16 – 26; col. 6, lines 24 – 52; and figure 5.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leland Jorgensen whose telephone number is 703-305-2650. The examiner can normally be reached on Monday through Friday, 7:00 a.m. through 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven J. Saras can be reached on 703-305-9720.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office, telephone number (703) 306-0377.

lrj

A handwritten signature in black ink, appearing to read 'Steven Saras', is positioned above the printed name and title.

STEVEN SARAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600